

REMARKS

Claim 37 has been canceled without prejudice or disclaimer as to the subject matter recited therein. In addition, claims 21, 32, 33, 36, 38, 39, and 41 have been amended. Moreover, two Declarations under Rule 132 are presented and the rejections of the Office Action traversed. Claims 21-36, 38, 39, and 41 remain pending. Further consideration and examination of the presently claimed application are respectfully requested.

Disclaimer of Priority

Applicant hereby disclaims priority to U.S. Application Serial No. 07/804,368. The best art relevant to examination appears to be Paul, and the Office Action (§ 2) takes the position that the claims currently presented are not entitled to the benefit of the earlier filing date. Applicant cannot find any published procedure for such disclaimer, and respectfully requests to be informed if such a procedure exists. Applicant is enclosing herewith a revised Application Data Sheet and a Disclaimer in which the priority claim to 07/807,368 has been removed.

Double Patenting

Claims 21-39 and 41 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,364,093 in view of U.S. Patent No. 5,524,081 to Paul (hereinafter “Paul”), U.S. Patent No. 5,326,095 to Dudley (hereinafter “Dudley”), or U.S. Patent no. 5,664,948 to Dimitriadis et al. (hereinafter “Dimitriadis”). This rejection is not affected by the priority disclaimer. Therefore, this rejection is respectfully traversed.

Double Patenting of the obviousness-type is “a judge-made criterion adopted out of necessity where the courts were faced with a situation in which claims in two applications or patents were not drawn precisely to the same invention . . .” *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F. 2d 683 (Fed. Cir. 1990). It does not appear that any case has

answered whether this judge-made doctrine has survived Congressional intervention when it amended 35 U.S.C. § 154(a) to a term of 20 years from the date of filing. *See*, Pub. L. 103-465.

When considering a double patenting rejection of the obviousness type, a comparison of the competing claims are made. That is, the earlier patent's disclosure is not available to show nonstatutory double patenting. *See*, *Gen. Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1281-82 (Fed. Cir. 1992). *See also*, MPEP 804B. 1 ("the disclosure of the patent may not be used as prior art").

Turning to the present application, the claims of U.S. Pat. No. 5,364,093 must be compared with the claims under examination. Probative, is the Office Action note in para. 2 that the claims under examination are not entitled to the benefit of the filing date of the '093 patent because the '093 patent did not disclose the claimed subject matter. This determination evidences that the present claims would not be considered by one of ordinary skill in the art as disclosed in the manner provided under 35 U.S.C. § 112, first paragraph. While applicant understands that the tests for obviousness and enablement are not identical, this ruling appears relevant to the question of obviousness in view of the '093 claims.

Comparing the present claims under examination, applicant cannot find a single claim in the '093 patent that would render the present claims obvious therefrom, either alone or in combination with Paul or Dudley. Claim 1 of '093 relates to a method for determining the approximate distance on a golf course, while claim 15 relates to an apparatus for determining the approximate distance. Claim 19 relates to tracking locations. None of the claims of '093 would fairly suggest the subject matter of the claims of the present application. For example, the present claims relate to methods and systems for "displaying an advertising message to a golfer on a golf course" at advertising locations. As noted *infra*, Paul relates to radio broadcasts of messages including advertising messages. Dudley relates to messages based on proximity to buried tags. Therefore, there is no motivation or suggestion to combine Paul or Dudley with the claims of the '093 patent, and even if such a combination were made, the present claim limitations are not met.

For at least the reasons stated above, Applicant asserts that the present claims are not taught or suggested by the claims of U.S. Patent No. 5,364,093 alone or in combination with Dudley or Paul. Accordingly, Applicant respectfully requests removal of this rejection.

Paragraphs 2-4 of Office Action of 10.25.06

Para. 2 –History of related Applications

The recitation of the related applications in the Office Action is helpful. Applicant understands the observation that the BPAI and CAFC held that the parent application #1 (07/804,368 now U.S. Pat. No. 5,364,093) did not disclose the location-specific transmission of advertising messages to the golfer using GPS. However, Applicant believes a fair reading of the CAFC decision rejects the basis for the decision of the BPAI, namely the combination of Wang, Fukushima and Dudley. Instead, the CAFC focused on the import of Paul which, although Paul was of record, was not argued or considered in the briefing before the BPAI or in the prosecution before the Patent Office. Applicant agrees that the teachings of Paul are relevant to the present examination.

Para. 3 - Subject matter of the Currently Presented Claims

The present claims have been amended to use the terminology “advertising information” versus “messages.” The Office Action notes that “the display of location-based advertising messages is not supported by the above-noted applications” (includes the ‘093 patent).

Para. 4 -The effective filing date of Paul and Dimitriadis

Applicant agrees that the effective filing date of Paul is May 2, 1994. There seems to be some confusion (or disagreement) as to the effective filing date of the relevant teachings of Dimitriadis et al. Applicant’s understanding is that Dimitriadis is a CIP of parent application 08/282,893 (abandoned) and that application no. 08/585,604 now U.S. Pat. No. 5,627,549 to Park (hereinafter “Park”) is a continuation (FWC) of parent application 08/282,893. Parent

application 08/282,893 has an effective filing date of July 29, 1994. The new matter in Dimitriadis has an effective filing date of October 11, 1994. Because Applicant believes it has demonstrated possession of the claimed invention prior to October 11, 1994, it is the teachings of parent application 08/282,893 as filed July 29, 1994 that is relevant *ipso verba* to the present examination. Rather than parse new matter from the parent disclosure, Applicant believes it useful to consider the specification of Park, which is identical to the teachings of parent application 08/282,893. To avoid confusion, Applicant is attaching as Exhibit A relevant portions of the preliminary amendment filed January 16, 1996 with the file-wrapper continuation request in parent application 08/282,893 (given Serial No. 08/565,604) (hereinafter “Park”).

As can be seen from Exhibit A attached hereto (the official file history is submitted under Rule 132 in a separate paper herewith) the preliminary amendment of January 16, 1996 first introduced the claims related to advertising locations that have been cited in the Office Action at para. 4. As set forth below, Applicant does not believe that the parent application 08/282,893 recites subject matter that detracts from the patentability of the currently presented claims. Instead, subject matter that may have detracted was first introduced in the preliminary amendment filed with the file-wrapper continuation (Serial No. 08/565,604) on January 16, 1996.

Section 102(e) Rejection under Paul

The Office Action proposes that claims 32, 33, 35, 37, 38,39, and 41 are rejected as anticipated by Paul. The standard for “anticipation” is one of fairly strict identity. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art of reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP 2131. Furthermore, anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, as arranged in the claim. *W.L. Gore & Assocs. V. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Using these standards, Applicants submit Paul fails to disclose each and every element of the currently pending claims as set forth in more detail below.

Applicant agrees with the Office Action in para. 10 that Paul discloses storing and displaying pro's notes based on location. However, the referenced claims have been amended and claim 37 canceled to make clear that the referenced claims relate to "advertising information." Paul does not disclose storing and displaying advertising information based on location.

Accordingly, Applicant asserts that independent claim 32 and claims dependent therefrom are not anticipated by Paul. Therefore, Applicant respectfully requests removal of this rejection.

Section 103 Rejection

The prior art rejections of claims 21-31 and 36 in paragraphs 16-20 of the Office Action under 35 U.S.C. § 103(a) remain for consideration. The Office Action took the position that the noted claims were unpatentable over a combination of U.S. Patent No. 5,524,081 to Paul in view of either U.S. Patent No. 5,326,095 to Dudley (hereinafter "Dudley") or U.S. Patent No. 5,664,948 to Dimitriadis et al. (hereinafter "Dimitriadis").

As noted above, Applicant is submitting a Declaration under Rule 132 which corroborates the Rule 131 Declaration originally submitted Feb. 17, 2005 swearing behind Dimitriadis. Applicant understands that the attachments are not altogether legible in the copies submitted on February 17, 2005. Although the computer in question clearly shows "creation" dates and possession of the claimed subject matter prior to October 11, 1994, the "old" computer does not permit printouts of the display (or how to do so is not known to Applicant). The photographs submitted with the Feb. 17, 2005 Declaration show creation dates prior to October 11, 1994 and the attached Declaration of CJ Hebert under Rule 132 verifies and corroborates the dates and the evidence. That is, the Declaration under Rule 132 is from an information technology specialist to verify the results of the "get info" function on the old Macintosh™ computer which stores the information contained in the Declaration filed Feb. 17, 2005.

The result of the Declarations is that any new matter contained in the CIP of Dimitriadis filed October 11, 1994 is not relevant in this examination. That is, only the disclosure of parent application 08/282,893 via file-wrapper continuation 08/585,604 is relevant. The passages in Dimitriadis (U.S. Pat. No. 5,664,948) by the Office Action, namely Col. 2, lines 3-21 and Col. 4, lines 24-39, are not present in parent application 08/282,893, and are new matter as of October 11, 1994. The best analog in parent application 08/282,893 is Col. 2, lines 8-21 and Col. 4, lines 35-55 in Park.

Applicant has carefully reviewed parent application 08/282,893 (and the FWC 08/585,604 now Pat. No. 5,627,549 to Park) and cannot find support for the proposition (advanced by the Office Action at para. 19) that parent application 08/282,893 teaches location based advertising. At most, parent application 08/282,893 teaches that the user/listener when he hears advertisements he is interested in, can receive directions from his present location to the location of the advertiser. See, e.g., Park -- Col. 4, lines 29 – 41, 55-57; Col. 5, lines 27-54; Col. 6, lines 41-54. Claims 1 and 2 of Park were not part of the application as filed (July 29, 1994) and are new matter added after October 11, 1994.

The Declarations under 37 CFR §§ 1.131 and 1.132 are effective in swearing behind Dimitriadis. Therefore, the rejection raised in paragraphs 11-14 of the Office Action as they relate to Dimitriadis have been obviated. The Declarations evidence conception of the applicable subject matter prior to October 11, 1994 -- the effective date of the relevant subject matter of Dimitriadis -- with diligence until filing on December 30, 1994.

The issue remains whether claims 21-31 and 36 are obvious under 35 U.S.C. § 103(a) from a combination of U.S. Patent No. 5,524,081 to Paul in view of U.S. Patent No. 5,326,095 to Dudley. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. As stated in MPEP 2143.01, the fact that references can be hypothetically combined or modified is not sufficient to establish a *prima facie* case of obviousness. See *In re Mills*, 916 F.2d. 680 (Fed.

Cir. 1990). Finally, the prior art reference or references when combined must teach or suggest all the claim limitations. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999); *In re Dance*, 160 F.3d 1339, 1343, 343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998) (“To establish a prima face case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.”) *See also*, MPEP 2143.03. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed Cir. 1991); MPEP 2143; *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (“When a rejection depends on a combination or prior art references, there must be some teaching, suggestion or motivation to combine the references.”); *Karsten Manufacturing Corporation v. Cleveland Golf Company*, 242 F.3d 1376, 1385, 58 U.S.P.Q.2d 1286 (Fed. Cir. 2001):

In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.

The motivation to combine prior art references most often comes from the references themselves and must be clear. In particular, broad conclusory statements are not evidence of a motivation to combine. *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1125, 56 U.S.P.Q.2d 1456 (Fed. Cir. 2000). Regardless of the source, there must be some evidence of a motivation to combine. *In re Dembiczak*, 175 F.3 at 999 (“The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.”)

First, there is no suggestion in Paul to make the proposed combination. Dudley is also inapposite, as it operates on a dissimilar principle based on proximity to buried tags. There is no reason to infer from Paul the limitations of the claims as presented. Paul mentions the ability to “broadcast” advertising, leader board updates, weather alerts etc. (Col. 8 lines 18-20). Nothing else in Paul relates to advertising. Paul does not teach the claim limitations nor suggest a need or combination for performing location based advertising. The Board’s reading of Paul is

essentially correct in the prior appeal mentioned in para. 2 of the Office Action. The Board states that “in addition to broadcasting the differential corrections in that it provides a mechanism for broadcasting messages to all carts or any specific cart. The broadcasts can include notices from the clubhouse, weather alerts, advertising, leader board updates, etc.” No reference can be found in Paul (by the Board or Applicant) that suggests advertising based on position on a golf course.

Of course, if the proposed modification or combination would change the principle of operation, then the references are not sufficient to render the claims *prima facie* obvious. *See, In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349 (CCPA 1959). The operating principle of Paul is to broadcast messages to all users, including advertising messages, regardless of position. Dudley operates to display information to a golfer based on proximity to a buried tag – *i.e.*, Dudley does not determine a position. Therefore, Dudley’s operating principle is different and the rejection was in error.

Even if Paul and Dudley are combined, the claim limitations are not taught or suggested by the proposed combination of Paul in view of Dudley. Again, Paul teaches only that messages, including advertising, can be broadcast over a radio to golfers. Dudley shows that messages, including advertising messages, can be triggered when in proximity to a buried tag. As such, Paul does not even suggest a problem of displaying advertising messages to users based on the users location, so there would be no motivation to combine the buried tags of Dudley.

For at least the reasons set forth above, Applicants assert that independent claims 21, 32, and 41, as well as claims dependent therefrom, are patentably distinct over the cited references. Accordingly, Applicants respectfully request removal of this rejection.

CONCLUSION

This response constitutes a complete response to the Office Action mailed October 25, 2006. In view of the amendments and remarks herein, Applicant asserts that pending claims 21-36, 38, 39, and 41 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned earnestly requests a telephone conference.

Respectfully submitted,
/Charles D. Huston/
Charles D. Huston
Reg. No. 31,027
ATTORNEY FOR APPLICANT

Customer No. 35617
Date: February 20, 2007

Attachments: Rule 132 Declaration of CJ Hebert
Rule 132 Declaration of Charles Huston
Amended Application Data Sheet
Priority Disclaimer

EXHIBIT A



#11/ Prec
OS 3/25/96

EXPRESS MAIL LABEL NO. EG 221-059-713 US
Date of Deposit: <u>Jan 10</u> , 1996
I hereby certify that this is being deposited with the United States Postal Service "Express Mail, Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.
By: <u>[Signature]</u>
Elmer Galbi, Reg. No. 19,761 Seiko Communications Systems, Inc. 1625 NW Amber Glen Court, Suite 140 Beaverton, OR 97006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PRIOR application:

Serial Number: 08/282,893

Filing Date: 07/29/94

Inventor(s) : Michael C. Park

Title: Dual Channel Advertising Referencing
Vehicle Location

Art Group: 2202

Examiner: BLUM, T

Docket: P126

Date of this paper: January 10, 1996

Preliminary Amendment Filed With FWC Application Responsive to the Office Action dated 07/18/95

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Please amend the above referenced application as follows:

In the Specification:

After the title and prior to the first line insert:

⚡ This application is a continuation of application Serial Number 08/282,893, filed
07/29/94 which is now abandoned. ~

In the claims:

Please cancel ~~claims~~ 1, 7, and 11.

Add claims 15, 16, and 17 as shown below.

15. A method for providing specific time and location sensitive advertising information to a moving vehicle, said specific time and location sensitive advertising information being selected from a large body of advertising information including a large number of records, each record including a specific time and location sensitive advertising information, the method comprising the steps:

transmitting to said vehicle by radio time said large body of advertising information,

receiving at said vehicle said large body of advertising information;

at a specific time, determining the location of said vehicle; and

selecting for display at said vehicle one of said records for display, said selection being at least in part based on the time of day and upon the location of said vehicle.

Subs
101

16. A method of providing time and location sensitive advertising information to the operator of a moving vehicle, the method comprising the steps:

receiving multiple data records by radio signal, each data record including time and location sensitive advertising information;

C-2
cancel

storing said data records;

calculating current location for said vehicle; and

selecting for display specific time and location specific advertising information depending upon the location of said vehicle;

displaying said selected time and location specific advertising information.

17. A method of providing travel information at a vehicle, the method comprising the steps:

collecting records relevant to multiple geographic points of interest, said information including a geographic location for each of said geographic points of interest;

C2
canceled

detecting said vehicle position;

selecting for display records based upon the relative location of said vehicle and the location of the geographic point in the selected record; and

displaying relative to a current location as established in said detecting step a distance to and a distance toward a selected one of said geographic points of interest.

REMARKS:

This is a preliminary amendment being filed with an FWC application. This preliminary amendment is being filed in response to the Office Action dated 07/18/95. A notice of appeal was filed in the parent application on 11/13/95.

Claims 15, 16 and 17 are now in this application. These claims correspond somewhat to previous claims 1, 7 and 11 which have been canceled.

Applicant's prior claim 1 was rejected under 35 U.S.C. §112 second paragraph as indefinite. The problem noted by the examiner has been corrected in the newly submitted claims.

Prior claims 1, 7 and 11 were rejected under 35 U.S.C. § 102 (b) based upon Kashiwazaki. The Kashiwazaki reference shows a system for a vehicle which includes a CD ROM 23 which stores data, a GPS receiver 20 which indicates the location of the receiver, and a memory 30 which stores Schedule data. A map is displayed from the data on the CD ROM. The location of the vehicle is determined by the GPS receiver. The location of the vehicle at any instant is compared to where the vehicle should be according to the schedule information, as indicated at column 6, lines 47 et. seq.

"In this manner, the schedule data as for the destination of driving, is stored and judged every time when the map is displayed, and the position of the destination and various information related to the destination are automatically displayed in the display map"

Thus, the purpose and operation of the system shown in Kashiwazaki are to determine the location of the vehicle relative to a pre-established schedule information which is stored in the system and to display information relative to the location of the vehicle.

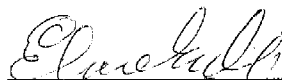
In contrast to the above, the applicant's system is directed to displaying time and location sensitive advertising information. With the applicant's system a large number

of information records are sent to the vehicle by radio. Each record includes a particular piece of time and location sensitive advertising information. At the vehicle the records are selected for display depending upon the time of day and upon the location of the vehicle. As stated in claims 15:

" said selection being at least in part based on the time of day and upon the location of said vehicle "

Applicant's system is dealing with a different type of information than is the reference and the selection process for displaying information is different. Since the reference does not show or suggest applicant's invention, allowance of claims 15, 16 and 17 is respectfully requested.

Respectfully submitted,



Elmer W. Galbi, Reg. No. 19,761
Seiko Communications Systems, Inc.
1625 N.W. Amber Glen Court, #140
Beaverton, Oregon 97006
Direct calls to: (503) 531-1516